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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/789,284 | 02/27/2004 | Joseph T. Unger | SCI-015 | 8205 |
| 23410 | 7590 | 05/20/2005 | EXAMINER | |
| COHEN SAKAGUCHI & ENGLISH LLP 2040 MAIN STREET, 9TH FLOOR IRVINE, CA 92614 | | | COLETTA, LORI L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3612 | |
| DATE MAILED: 05/20/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,284

Applicant(s)

UNGER ET AL.

Examiner

Lori L. Coletta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 11-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☒ Claim(s) 8 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09212004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 11-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on March 22, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagashima et al. US 2002/0180246.

Regarding claim 1, Nagashima et al. '246 discloses an apparatus for covering a seam extending between first and second panel (3 and 4) of a vehicle, the first and second panels comprising opposing shoulders adjacent the seam at least partially defining a ditch (2) having a width and a height, comprising an elongated section of molding (8) comprising first and second ends, an upper surface (12) comprising a desired aesthetic finish for the vehicle, and a lower surface (15); and a plurality of mounts (13) extending from the lower surface and spaced apart from one another between the first and second ends of the molding, each mount comprising a width less than the width of the ditch such that the mount may be secured in the ditch to the vehicle, each mount comprising a height such that, when the mounts are secured in the ditch, the molding extends along the ditch without touching the shoulders in Figure 2B.

Regarding claim 1, Nagashima et al. '246 discloses an apparatus for covering a seam extending between first and second panel (3 and 4) of a vehicle, the first and second panels comprising opposing shoulders adjacent the seam at least partially defining a ditch (2) having a width and a height, comprising an elongated section of molding (21) comprising first and second ends, an upper surface (22) comprising a desired aesthetic finish for the vehicle, and a lower surface (24); and a plurality of mounts (20 and 23) extending from the lower surface and spaced apart from one another between the first and second ends of the molding, each mount comprising a width less than the width of the ditch such that the mount may be secured in the ditch to the vehicle, each mount comprising a height such that, when the mounts are secured in the ditch, the molding extends along the ditch without touching the shoulders in Figure 4B.

Regarding claim 2, Nagashima et al. '246 discloses the apparatus, further comprising flexible trim (18) extending along at least one side of the molding (21) at least partially between the first and second ends, the flexible trim contacting at least one of the shoulders when the mounts (20 and 23) are mounted in the ditch (2) in Figure 4B.

Regarding claim 3, Nagashima et al. '246 discloses the apparatus, wherein the molding (8 and 21) comprises a substantially rigid member (11) having a shape between the first and second ends contoured to conform substantially to a contour of the first and second panels (3 and 4) in Figures 2A and 4B.

Regarding claim 7, Nagashima et al. '246 discloses the apparatus, wherein the desired finish comprises paint.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima et al. US 2002/0180246 in view of Yoon 6,568,748.

Regarding claims 4-6, Nagashima et al. '246 discloses the apparatus.

However, Nagashima et al. '246 does not show a roof rack member extending from the upper surface of the molding (claim 4); the roof rack member is mounted to the molding opposite the mounts (claim 5); and the roof rack member is mounted to the molding at the mounts (claim 6).

Yoon '748 teaches a roof rack member (40) mounted to the molding (20) in Figure 2.

Regarding claims 4-6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the apparatus of Nagashima et al. '246 with a roof rack member extending from the upper surface of the molding, as taught by Yoon '748, in order to easily mount to and dismount from the roof molding in order to increase the user's convenience.

Regarding claim 9, Nagashima et al. '246 discloses an apparatus for covering a seam extending between first and second panels of a vehicle, the first and second panels comprising opposing shoulders at least partially defining a ditch having a width and a height, comprising an elongated substantially rigid section of molding comprising first and second ends defining a

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longitudinal axis between, an upper surface, and a lower surface; a plurality of mounts extending from the lower surface and spaced apart from one another between the first and second ends of the molding, each mount comprising a width less than the width of the ditch such that the mount may be mounted in the ditch to the vehicle, each mount comprising a height such that, when the mounts are mounted in the ditch, the molding extends along the ditch without touching the shoulders.

However, Nagashima et al. '246 does not show a roof rack member extending from the upper surface of the molding, and attached to the molding adjacent the plurality of mounts.

Yoon '748 teaches a roof rack member (40) extending from the surface of the molding (20), and attached to molding adjacent the plurality of mounts in Figure 2.

Regarding claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the apparatus of Nagashima et al. '246 with a roof rack member extending from the upper surface of the molding, and attached to the molding adjacent the plurality of mounts, as taught by Yoon '748, in order to easily mount to and dismount from the roof molding in order to increase the user's convenience.

Allowable Subject Matter

6. Claims 8 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The cited references show several other apparatuses similar to that of the current invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori L. Coletta whose telephone number is 571-272-6658. The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lori L. Coletta
Lori L. Coletta
Primary Examiner
Art Unit 3612

llc
May 10, 2005